

10-27-04

1635 A
Jewell



Attorney's Docket No. 3477-95

PATENT

OCT 26 2004

IN THE UNITED STATES DESIGNATED OFFICE (DO/US)

In re: Aubin et al.

Serial No.: 10/089,429

International Filing Date: August 30, 2000

For: *ESTROGEN RELATED RECEPTOR ERR α ,
A REGULATOR OF BONE FORMATION*

Group Art Unit: 1635

Examiner: J.E. Aubin

Confirmation No. 6914

Date: October 26, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

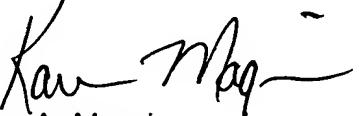
Response to Restriction Requirement

In response to the Restriction Requirement dated July 14, 2004, Applicants elect the claim of Group V (claim 2; drawn to a method of increasing differentiation of osteoblasts by administering an ERR α agonist) with traverse, as Applicants respectfully submit that it would not be an undue burden to examine all of the claims concurrently. In particular, it would not be an undue burden to search and examine the entire scope of claim 2 (*i.e.*, Groups V to VIII). Further, the Restriction Requirement allegedly utilizes the unity of invention criteria of PCT Rule 13.1; however, no restriction for lack of unity of invention was issued during the international stage, whereas the present Restriction Requirement is quite onerous and places an unreasonable burden on the Applicants as it requires the Applicants to file at least 35 separate applications to pursue the subject matter of the originally filed 15 claims.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding Restriction Requirement.

This application is in condition for substantive examination, which action is respectfully requested.

Respectfully submitted,


Karen A. Magri

Registration No. 41,965

In re: Aubin et al.
Serial No.: 10/089,429
International Filing Date: August 30, 2000
Page 2 of 2

CERTIFICATE OF EXPRESS MAILING

"Express Mail" mailing label number: EV473665625US Date of Deposit: October 26, 2004
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express
Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is
addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Sarah Brunmeier
Sarah Brunmeier

Customer No. 20792
Myers Bigel Sibley & Sajovec, P.A.
P. O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401